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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/774,359 | 02/05/2004 | John C. Hill | 511-007 | 8409 |

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EXAMINER

VENKAT, JYOTHSNA A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1615

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---|------------------------------------|--|
| Office Action Summary | Application No. 10/774,359 | Applicant(s) HILL ET AL. | |
| | Examiner JYOTHSNA A. VENKAT Ph. D | Art Unit 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,8-15 and 17-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,8-15 and 17-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Examiner of this application is changed from Sharon Howard to **Jyothsna Venkat**.

Claims 1-4, 6, 8-15 and 17-31 are pending in the application and the status of the application is as follows:

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 2-3 recite that the compositions has a melt temperature ranging between 40-60 and 47-51. There is no proper antecedent basis for the claims. These claims were originally filed with the specification.

Applicants are notified that the serial number at col.6 of patent 6,436,379 should be 09/329,882 and not 09/329,822. Applicants are also notified that the patent that matured into patent with respect to serial number 09/010,736 should be 6,280,746 and not 5,968,530 (see col.2 and col.6 of patent 6,436,379).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6, 8-15 and 17-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is new matter rejection.

Amendment dated 3/3/05 added the expression " esterified compounds at least partially derived from at least one of natural seed and nut oils". There is no support in the specification for the esterified compounds, which are partially derived from natural seeds and oils.

In accordance with MPEP 714.02 applicants should specifically point out support for any amendments made to the disclosure.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6, 8-15 and 17-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3 recites the limitation "semi-solid emollient composition", where as claim 1 recites" a cuticle treatment and conditioning composition" and semi-solid emollient. There is insufficient antecedent basis for this limitation.

Claim 4 and claim 6 recites the limitation "product", where as claims 2-3 recites" semi-solid emollient composition" and claim 1 recites "a cuticle treatment and conditioning composition". There is insufficient antecedent basis for this limitation.

Claim 8 recites the limitation "semi-solid emollient composition", where as claim 2 lacks antecedent basis with respect to claim 1.

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Claims 11-12 recites the limitation "semi-solid emollient composition", where as claim 10 recites "a product for treating cuticles". There is insufficient antecedent basis for this limitation.

Claims 13-14, 17, 19 and 22 would better read by changing the dependency from claim 11 to claim 10 since claim 11 lacks antecedent basis with respect to "product".

Claims 5 and 14 are broader in scope since the claims comprise "esterified". Note that the expression "partially esterified" is drawn to new matter.

Applicants are notified that there is no support in the patents 6,280,746 and 5,968,530 for the claimed subject matter drawn to "cuticle treating composition" and "product for treating cuticles".

In response to the new matter rejection, if applicants amend the claims to delete the new matter, applicants are notified that patents cited *supra* are prior art since the instant Reissue is CIP of applications, which matured into patents 6,280,746 and 5,968,530. Applicants are also notified if the new matter is deleted, then obviousness –type double patenting rejection is applicable with respect to patents 6,436,379, 5,968,530 and RE 38,141.

Claim Rejections - 35 USC § 103

Claims 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. patents 2,399,463 ('463) and 6,280,746 ('746).

Instant application is claiming method for treating a cuticle using a semi-solid emollient compositions comprising the steps of providing the semi-solid composition in a container and applying the composition on a selected area without touching the composition with finger tips.

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Patent '463 teaches holder and applicator for cosmetic liquids and the like. See the figures; see col.1, lines 1-4 where the patent teaches applying cosmetics to cuticle and nails. Patent at the same column lines 35-50 teaches that the applicator can be in the form of fountain pen barrels and caps. See also pages 2 for the explanation of the figures. The composition is applied without touching the composition with fingertips. The difference between the patent and the instant application is the patent teaches liquid whereas in the instant application it is to semi-solid composition. However, patent '746 teaches emollient composition and it also teaches that it can be applied in cosmetics. See the abstract, see paragraph bridging col.s 7-8, where the patent teaches that emollient composition which is formed jojoba esters can be warmed to just above their melting point and the molten blend can be poured into dispensing device. Patent also teaches that the composition can be applied using the packaging material with respect to claims 25-29, all the steps are conventional in the cosmetic art when applying composition from the container. These are opening the container, and step of extruding the composition past the opening container and replacing the cap after applying the composition. These steps do not impart any patentability to the claims.


Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the applicator of '463 for treating the cuticle and use the composition into the container use the applicator by pushing the pen so that the composition can be applied to the cuticle. One of ordinary skill in the art would be motivated to use the applicator of patent '463 with the reasonable expectation of success that composition can be applied to the cuticle without touching the composition with hand. This is a prima facie case of obviousness.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K. PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT Ph. D
Primary Examiner
Art Unit 1615
